

## **REMARKS**

Claims 1-43 remain pending in the instant application (hereinafter, the "237 Application") and stand finally rejected. It is believed that the Rule 131 Declaration and the remarks submitted herewith attend to and serve to overcome all issues raised in the final Office Action dated April 19, 2006. With the exception of the sub-headings titled "Change of Inventorship" and "Improper Final Rejection", the sub-headings used herein correspond to the order of issues presented in the April 19 Office Action.

### **Change of Inventorship**

Before turning to the Office Action of April 19, 2006, we draw the Examiner's attention to the Request for Change of Inventorship filed herewith. Kirk Sigel is added as an inventor, as further explained in the attached Request. Accordingly, the Declaration under 37 C.F.R. §1.131, also filed herewith and discussed below, lists and is signed by Kirk Sigel.

### **Improper Final Rejection**

Before addressing the specific rejections presented in the aforementioned Office Action, we note that there is some confusion as to its finality. The Office Action Summary and the PAIR system indicate that the pending Office Action is non-final. However, the Examiner concludes the Office Action by stating that the action is final, and that Applicant's amendment necessitated the new ground(s) of rejection. We respectfully disagree.

First, the amendment in question appears to relate to the spacing of optical fibers, in particular, Applicants' first and second optical fibers having a lesser distance (first distance) between the ends of the optical fibers that are oriented toward a field of view than the distance (second distance) between the ends of the optical fibers that are oriented toward a sensor segment. However, this spacing of optical fibers is described in claim 29, which is original. Claim 29 particularly recites an apparatus for effectively reducing a non-active gap of an optical sensor, comprising:

- a first optical fiber and a second optical fiber mounted to each other such that a first end of said first optical fiber and a first end of said second optical fiber are oriented toward a field of view; and
- a first spacer mounted between a second end of said first optical fiber and a second end of said second optical fiber to locate said second end of said first optical fiber and said second end of said second optical fiber further apart than said first end of said first optical fiber and said first end of said second optical fiber and to correspond to elements of an optical sensor.

The Examiner's final rejection of claim 29 is not necessitated by applicant's amendment of claim 29, notably because claim 29 has never been amended. The finality of the April 19, 2006 Office Action is therefore, respectfully, improper.

In addition, we submit that the final rejection of other pending claims is also improper because the claims (e.g., claims 1 and 15) were amended to incorporate a limitation already described in claim 29. These claims were essentially amended to incorporate a limitation that has been present elsewhere in the claims since the '237 Application was filed. Per MPEP, a final rejection is improper where the Examiner introduces a new ground of rejection that is not necessitated by applicant's amendment of the claims:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is *neither necessitated by applicant's amendment of the claims nor based on an information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. §1.97(c)* with the fee set forth in 37 C.F.R. 1.17(p)." MPEP 706.07(a), emphasis added.

Per the MPEP, quoted above, a rejection should also not be final when based on new grounds of rejection that were not submitted in an IDS filed under 37 C.F.R. § 1.97(c). However, the Examiner rejects claims 1-43 based upon new references that were not submitted in an IDS. The finality of the April 19, 2006 Office Action is

therefore improper for at least two reasons: it is based on new references not cited in an IDS, and it is not necessitated by Applicant's amendment.

Accordingly, we submit that the final rejection is premature, and we request the Examiner's reconsideration, and withdrawal of the holding of finality. Per MPEP 706.07(d), "If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection."

### **Claim Rejections – 35 U.S.C. § 102**

Claims 42-43 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. US2004/0178329 (hereinafter, "Kare"). We respectfully disagree and traverse the rejection, for at least the following reasons.

First, Kare is not prior art to the inventions of claims 42 and 43. We enclose a declaration under 37 C.F.R. §1.131 and MPEP § 715 to antedate Kare. The attached declaration specifically shows conception and possession of the invention prior to the effective date (March 13, 2003) of Kare and due diligence from this conception to the effective filing date of the '237 Application. In particular, the enclosed Rule 131 Declaration and Exhibits evidence a continuing series of actions taken in development of Applicant's method and apparatus to effectively reduce the non-active gap of an optical sensor, from April of 2000 through the filing of the present application on October 20, 2003. These actions include reviewing, revising and re-working a confidential draft application (which, over time, developed into the '237 Application) at least as early as May, 2001. See Exhibit 2. This draft antedates Kare by at least 21 months.

Accordingly, Kare is inapplicable as prior art to the '237 Application. However, even Applicant's Declaration did not antedate Kare by almost two years (and it does serve this purpose), Kare does not teach or suggest each and every limitation of claims 42 and 43.

Independent Claim 42: Claim 42 recites an apparatus for effectively reducing a non-active gap of an optical sensor, including:

- (a) means for obtaining optical information from a field of view; and
- (b) means for orienting said optical information to at least two linear sensor elements of at least one optical sensor so as to enhance an optical congruence capability of said optical sensor.

Pursuant MPEP 2181(I), "a claim limitation will be interpreted to invoke 35 U.S.C. § 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function."

The limitations of claim 42 (A) use the phrase "means for", (B) modify the phrase "means for" by functional language, and (C) the phrase "means for" is not modified by sufficient structure, material or acts for achieving the specified function. The claim therefore meets the 3-prong analysis, and should be treated under 35 U.S.C. § 112, sixth paragraph.

The following is a quote from 35 U.S.C. 112, sixth paragraph:

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and ***such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.***" (emphasis added).

Furthermore,

"The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure." *In re Donaldson*, 16 F.3d 1189, 29 U.S.P.Q.2D 1845 (Fed. Cir. 1994).

We respectfully submit that, contrary to the Examiner's note, Kare does not disclose an optical sensor that is functionally equivalent to Applicants' apparatus for effectively

reducing a non-active gap of an optical sensor. For example, Applicant clearly recites "the use of optical fibers oriented to obtain visual images from a field of view at one location *and distribute components of the optical images to more widely-spaced sensor elements of one or more optical sensors.*" Specification p. 3, lines 12-15. Applicant's optical fibers are described as oriented closer together at a first ends, proximate a field of view, and further apart at second ends, oriented toward a sensor element: "The ends of the optical fibers 130 that are coupled to the second fiber optic faceplate 120 are further separated from each other than the ends of the optical fiber 130 coupled to the first fiber optic faceplate 110." Specification p. 10, lines 1-3. As the Examiner notes in the pending Office Action, "Kare et al fail to explicitly disclose that the second optical fiber having a first end that is located a first distance that is less than the first width and that the second distance from the second end of the optical fiber is greater than the first distance." Office Action, p. 3, final two lines – p. 4, line 1. Kare therefore does not disclose equivalents to (e.g., the particular spacing of) Applicant's means for obtaining and orienting optical information.

*Dependent Claim 43:* Claim 43 depends from claim 42, and thus benefits from like argument. Furthermore, claim 43 requires means for positioning said means for obtaining in relation to said optical sensor. We submit that the means for positioning of claim 43 also invokes 35 U.S.C. 112, sixth paragraph. We note that Kare does not teach or suggest equivalents to Applicant's means for positioning. For example, as noted above, Kare does not teach obtaining visual images from a field of view at one location and distributing components of the optical images to more widely-spaced sensor elements. Kare therefore also cannot teach means for positioning the "means for obtaining" to distribute components of optical images to more widely-spaced sensor elements in such relation to the optical sensor.

As shown, Kare does not disclose equivalents to (e.g., the particular spacing of) Applicant's means for obtaining and orienting optical information. Furthermore, Kare is unavailable as prior art to the inventions of the '237 Application. We therefore contend

that claims 42 and 43 are allowable over Kare. Withdrawal of the Examiner's rejection, and allowance of claims 42 and 43, are respectfully requested.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 1-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kare in view of U.S. Patent Application Publication No. US2004/0109653 (hereinafter, "Kerr"). We again respectfully disagree and traverse the rejection, at least because neither Kare or Kerr are prior art to the inventions of claims 1-41. The enclosed declaration under 37 C.F.R. §1.131 also antedates Kerr, specifically showing conception and possession of the invention prior to the effective date (December 9, 2002) of Kerr and due diligence from this conception to the effective filing date of the '237 Application. For example, the aforementioned Exhibit 2 draft application antedates Kerr by more than 18 months.

Both Kare and Kerr are unavailable as prior art to the inventions described in the '237 Application and claims. For at least this reason, the rejection under 35 U.S.C. §103(a) fails. Accordingly, we request withdrawal of the Examiner's rejection, and allowance of claims 1-41.

### **Response to Arguments**

We thank the Examiner for his consideration of our arguments filed January 23, 2006.

Under the Response section of the April 19, 2006 Office Action, the Examiner states that "the applicant explicitly acknowledge [sic.] that Richardson teaches optical fibers that are farther apart at an input end and closer together at an output end. " Office Action of 4/19/2006, p. 16, first paragraph. The Examiner then draws parallels to Kare, and states that because of Applicant's reasoning, Kare explicitly discloses optical fibers that are farther apart at an output end than at an input end. We respectfully disagree; however, regardless of Kare's teaching, as clearly evidenced by the co-filed Rule 131 Declaration and Exhibits, Kare is not prior art to the '237 Application.

## CONCLUSION

Given the remarks presented herein and the Declaration under 37 C.F.R. §1.131, we submit that each rejection presented in the Office Action of April 19, 2006 is overcome. We respectfully request withdrawal of each of the Examiner's rejections and allowance of claims 1-43.

A Petition for Two Months' Extension of Time to Reply is submitted herewith, along with authorization to charge the required fee of \$225 to deposit account no. 12-0600. No other fees are believed due. However, if any additional fee is deemed necessary in connection with this Response, the Commissioner is hereby authorized to charge this fee to the aforementioned deposit account. If any issues remain outstanding, or if any questions arise regarding this Response or the co-filed Rule 131 Declaration or Request to Correct Inventorship, the Examiner is encouraged to telephone Applicant's attorney, Curtis A. Vock, at (720) 931-3011.

Respectfully submitted,

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Date

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